

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Inventors: Ola OLOFSSON et al.

Art Unit: 3637

Application No.: 09/806,941

Examiner: P. Tran

Filed: April 6, 2001

For: FLOORING MATERIAL COMPRISING BOARD SHAPED
FLOOR ELEMENTS WHICH ARE JOINED VERTICALLY BY
MEANS OF SEPARATE ASSEMBLY PROFILES

**PETITION TO THE DIRECTOR
TO SUSPEND THE RULES UNDER 37 CFR 1.183**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

I. Statement of the Facts

This case is on appeal and an Appeal Brief had been filed on July 24, 2006, and the Examiner's Answer having been mailed October 3, 2007. Thus, under 37 CFR Section 41.47(b) a request for oral hearing was due within two (2) of the date of Examiner's Answer *i.e.*, by December 3, 2007. The matter was docketed for filing a Request for Oral Hearing by the staff of the undersigned's Firm for filing on December 3, 2007.

When such matter came up on the docket for December 3, 2007 the undersigned's legal assistant advised the undersigned that in anticipation of the change in the rules effective November 1, 2007, that a Request for Continuing Examination (RCE) had been filed in connection with the above-identified application, thereby mooting the Request for Oral Hearing.

In fact, the information conveyed to the undersigned was in error and no RCE had been filed and thus the date of December 3, 2007 to file a Request for Oral Hearing was still in effect. No Request for Oral Hearing was filed and the time for filing such request is not extendable under either 37 CFR 1.136(a) or (b).

II. Specific Relief Requested

Petitioner requests that in the interest of justice in an extraordinary situation that the Director suspend Rule 41.47(b) and/or (g) and accept the one-day late filing of a Request for Oral Hearing, as attached hereto.

Although the Patent Rules, specifically 37 CFR 41.47(b) specifies that the "Request for Oral Hearing" be filed within two months of the date of the Examiner's Answer, there is no statutory requirement for that time period. In the present circumstances the date for filing is but one day later than the required due date and no intent to delay is occasioned by this late filing.

The Office will not be unduly prejudiced in accepting the one day late filing as it will not delay docketing of the Appeal at the Board of Patent Appeals and Interferences, nor ultimately delay resolution of this appeal.

The oral hearing is deemed necessary by petitioner to proper presentation of the issues on appeal, and while mindful of the Office position that an oral hearing may be refused even if timely requested, the undersigned's twenty years plus of extensive practice before the Board of Patent Appeals and Interferences, has found it helpful to the Board in understanding issues, though briefed, raise questions in the mind of the Administrative Patent Judges that can only be answered in person by counsel at the oral hearing.

III. A Verified Declaration by the Undersigned's Legal Assistant Attesting to the Facts Set Forth Therein also Accompanying this Petition

The undersigned's Legal Assistant, Marilyn V. Johnson, advised the undersigned on December 3, 2007 that the docketed entry for Request for Oral Hearing due that date superseded by the filing of a RCE. Her Declaration in support is attached hereto.

U.S. Application No. 09/806,941
Group Art Unit: 3637

IV. Fees

The fees for this Petition, together with any additional fees such as the fees set forth in 37 CFR 1.136(a) may be charged to the undersigned's **Deposit Account No. 19-4375**.

Respectfully submitted,



Thomas P. Pavelko
Registration No. 31,689

Date: December 4, 2007

TPP/mvj

ATTORNEY DOCKET NO. TPP 31386

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Inventors: Ola OLOFSSON et al.

Art Unit: 3637

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For: FLOORING MATERIAL COMPRISING BOARD SHAPED
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**DECLARATION OF MARILYN V. JOHNSON WITH
ACCOMPANYING PETITION TO THE DIRECTOR
TO SUSPEND THE RULES UNDER 37 CFR 1.183**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

I, Marilyn V. Johnson, residing at 1419 Pangbourne Way, Hanover, Maryland 21076 since January 28, 2005, make these statements on personal knowledge.

I am presently employed at Stevens, Davis, Miller & Mosher, L.L.P. and I work as the Legal Assistant to Thomas P. Pavelko, Partner of the Firm.

I have seven years of experience in the Intellectual Property area and very familiar with the practice, including docket entries and the importance of timely responding to the docketed due dates.

Specifically in connection with the above-identified Application Mr. Pavelko asked me on December 3, 2007 in connection with the docketed due date for a Request for Oral Hearing, if I was preparing the Request.

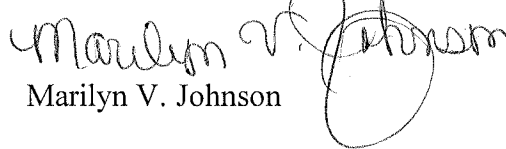
In late October, 2007, in anticipation of the rule change regarding RCE and continuation practice, we filed many RCEs, including RCEs of applications that were in the appeal process.

I mistakenly advised Mr. Pavelko, in response to his inquiry about the Request for Oral Hearing in this Application, that such was not needed because we filed an RCE in the above-captioned Application.

Through my confusion in filing a number of RCEs for the same client to which this application is assigned, I mistakenly gave Mr. Pavelko incorrect information advising him that an RCE was filed in this case, when in fact no RCE was filed in this case.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon

Respectfully submitted.


Marilyn V. Johnson

Dated: December 4, 2007

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.41 Reply brief.

(a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c) Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.43 Examiner's response to reply brief.

(a)(1) After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

(2) A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

(b) If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the

time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.47 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing.

(b) If appellant desires an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or supplemental examiner's answer.

(c) If no request and fee for oral hearing have been timely filed by appellant as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant has complied with all the requirements of paragraph (b) of this section, a date for the oral hearing will be set, and due notice thereof given to appellant. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. A hearing will be held as stated in the notice, and oral argument will ordinarily be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered.

(e)(1) Appellant will argue first and may reserve time for rebuttal. At the oral hearing, appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the brief or reply brief except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and evidence relied upon in an answer or a

supplemental answer except as permitted by paragraph (e)(2) of this section.

(2) Upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(f) Notwithstanding the submission of a request for oral hearing complying with this rule, if the Board decides that a hearing is not necessary, the Board will so notify appellant.

(g) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 41.50 Decisions and other actions by the Board.

(a)(1) The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. The Board may also remand an application to the examiner.

(2) If a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) *Reopen prosecution.* Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. A request that complies with this paragraph

will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(ii) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section.

(b) Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

(c) The opinion of the Board may include an explicit statement of how a claim on appeal may

memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) and (g), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (a), (a)(2)-(3), (c)-(e) & (g) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(3) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the

authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

[47 FR 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

§ 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

§ 1.184 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

§ 1.191 Appeal to Board of Patent Appeals and Interferences.

Appeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(a) and (b) are conducted according to part 41 of this title.

[46 FR 29183, May 29, 1981; para. (a), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (b) and (d) amended, para. (e) added, 54 FR 29553, July 13, 1989, effective Aug. 20, 1989; para. (d) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a) and (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001;